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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,129	12/20/2001	Christine J. Landry-Coltrain	83466LMB	2382

7590 03/21/2006  
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EXAMINER
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SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/028,129		LANDRY-COLTRAIN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Pamela R. Schwartz		1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 6-9, 11-43 is/are pending in the application.
- 4a) Of the above claim(s) 26-28 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-9,11-25 and 29-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____                                    |

1. Indication of allowable subject matter is withdrawn in view of the following rejections.
2. Claims 1, 2, 6-9, 11-25 and 29-42 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-45 and claims 1-54 respectively of copending Application Nos. 10/271,082 and 10/271,057. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims disclose porous polyester particles for inclusion in at least one ink receiving layer of an ink jet recording element. It would have been obvious to one of ordinary skill in the art to include the particles in both layers or in either ink receiving layer of the medium and to include conventional materials and layers in the medium. With respect to particle size, the claims of the applications recite a mean diameter of less than 0.5 microns. Based upon this disclosure it would have been obvious to one of ordinary skill in the art to primarily include particles that are less than 0.5 microns.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1, 2, 6-9, 11-25 and 29-42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6,866,902. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims disclose an ink jet recording element with at least one ink receiving layer including porous polyester particles of particle size between 0.01 and 10 microns. From this disclosure, it would have been

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obvious to one of ordinary skill in the art to use particles less than 0.5 microns in size since such particles are within the disclosed size range.

4. Claims 1, 2, 6-9, 11-25 and 29-42 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-36 of copending Application No. 10/118,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims disclose an ink jet recording element with at least one ink receiving layer including porous polyester particles of particle size between 0.01 and 10 microns. From this disclosure, it would have been obvious to one of ordinary skill in the art to use particles less than 0.5 microns in size since such particles are within the disclosed size range..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-9, 19-25, 34, 35 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Okumura et al. (5,360,780) for reasons of record and for reasons given below.

6. Claims 1, 2, 6-9, 11-25, 33-39, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura et al. (5360780) for reasons set forth above and for the following reasons. With respect to claim 18, since the reference has a glossiness

and control of this property in col. 13, it would have been obvious to one of ordinary skill in the art to select particles that result in the desired level of glossiness.

7. Applicant's arguments filed December 17, 2005 have been fully considered but they are not persuasive. With respect to Okumura et al., applicants' showings are unpersuasive because they are not directed to the reference but to another thermal print paper. The composition of the paper layers is not disclosed so no direct comparison can be made with the applied prior art to determine if it is representative of the applied art. In addition, there are numerous ink jet ink formulations that are designed to be used with a specific paper and give better results with that specific paper. Applicants do not disclose this composition either. Consequently, a general determination that the thermal print paper of the reference cannot be used for ink jet printing is not supported by the Declaration of December 27, 2005.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz  
March 16, 2006



PAMELA R. SCHWARTZ  
PRIMARY EXAMINER